



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,959	07/30/1999	KEN HAYWARD	690-008568-U	1141

7590 08/27/2002

MARK F HARRINGTON
PERMAN AND GREEN LLP
425 POST ROAD
FAIRFIELD, CT 06430

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 08/27/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/364,959

Applicant(s)

HAYWARD ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This communication is responsive to amendment filed on June 05, 2002.

Applicant amends claim 1.

Response to Applicant's Remarks

1. Applicant remarks that Cotte et al fails to disclose a display exclusively used by the transfer device. The paper input device has no display of its own, but has software that utilizes a display on host computer 110. The display on host computer 110 is used for any application that may be running and is not exclusive to paper input device.

It is noted that the display claimed in claim 1 "exclusively used by the image transfer device and not exclusively used by the reader. In Cotte et al, the electronic assembly with an image transfer device (Fig.12) comprises at least the input device 214 and the computer 210 with display 250. Cotte teaches that the display 250 is exclusively used by the transfer. For instance, the insertion of the paper in the input device 214 causes a code to be sent over the RS232 cable to the input device software resident on the host 210. This code is an interrupt which vectors processing by the host to a service routine which then reads the incoming serial data from the input device and stores it in a file. "The software of the input device resident on the host also generates a drop down menu 250 representing options to the user regarding what should be done with the scanned image." (col. 10, lines 29-58). Thus, since the input device 214 can control the host computer and has the priority over the host computer, the display is exclusively used by the

Art Unit: 2622

image transfer device for displaying an image transfer menu for effecting transfer of the image scanned by the input device 214 (Fig. 17).

In order to overcome Cotte's teaching, applicant should clarify that the display 24 is included in the transfer means 12 and not the display of the computer 14.

2. Applicant remarks that Cotte et al fails that the image transfer device has a first and second type of image transfer menu available for display on the image transfer device, depending on whether the image transfer device is connected to the computer. In other words, the menus described in the office action are displayed on the display of computer 110 and not on an image transfer device. Cotte et al's scanner has no display for menus and thus has no capability to display different menus depending on whether a computer is connected or not.

It is noted that when the input device 214 detects the presence of the document, it scans the document and transferred it to the host computer. In this case, the host computer is connected to the transfer device and it functions for the transfer device such as receiving, storing, processing and transmission of the scanned data. When the input device 214 is inactive, the transfer device is not connected to the host computer, or the host computer does not connected to the transfer device. As previously stated, when the host computer receiving an interrupt from the input device, the software of the input device resident on the host also generates a drop down menu 250 representing options to the user regarding what should be done with the scanned image. Thus, the drop down menu is different from the menu of the computer since it is used for the transfer device. For instance, Cotte teaches different menus used for the transfer device in Figs. 14-17, 26-30 which are different from menus for the computer since the computer uses the

Art Unit: 2622

software programs of the input device resident on the host computer to generate. When the computer does not connect to the input device, it does not use the software programs of the input device but its own software program to generate the menu. It was commonly known in the art that the menus for the computer used in the host are not the menus for the transmission from the scanned data from the transfer device since the host computer does not use the software of the input device to control the host computer. Therefore, they are different with the menus used for transferring the scanned data from the transfer device.

3. Applicant remarks that the regular menu displayed in Cotte et al is not an image transfer menu of any kind. The only image transfer menu available for display is the menu that appears in response to the sensors 222 (Fig. 12) sensing a document.

Cotte et al does not specifically teach a regular transfer menu in case the host computer is not connected to the transfer device. However, Cotte teaches in Fig. 17 the menu options including "Send this image as an E-mail message" which shows that the host computer can transmit and receive electronic mail. It was commonly known in the art that a conventional computer can transmit and receive emails. Thus, in the case the input device 214 is not connected to the host computer, the host computer has a menu with an option of sending an electronic mail. This menu differs from the menus in Figs 14-17, 26-30 since the host computer does not receive any scanned document from the input device 214.

Art Unit: 2622

4. Applicant remarks that the drop down menu 250 and the screen shown in Fig. 17 are generated in response to sensors 222 sensing a document, not in response to a computer being connected or not.

In Fig. 10, the input device includes a microprocessor 352 for controlling the input device, the interruption of the host computer, the transferring of the scanned data to the host computer, and the software programs of the input device resided in the host computer. Cotte teaches "Figs. 11B and 11C are flow diagrams of the software executed by the microprocessor of the input device to manage the passthrough" connection from the host to another peripheral so that the input device can share a single data port with, for example, a Fax modem." (col. 4, lines 22-27), "Fig. 23 is a flow chart of processing by input device software resident in both the paper input device and the host to implement a photocopy option in addition to or in lieu of the other processing previously described herein" (col. 5, lines 3-6). Cotte further teaches "The interrupt causes the host 210 to stop whatever it is doing and vector processing to an interrupt service routine assigned to input device 214 (col. 15, lines 7-25), and "The input device software resident in the host automatically generates the menu options" (col. 15, lines 36-42), and "the microprocessor automatically starts the scanning processing" (col. 21, lines 33-44). Thus, the microprocessor 352 controls the software programs resident in both the input device and the host computer when the sensors detect the presence of a document in the input device since the interruption causes the host 210 to stop whatever it is doing while "the input device software will automatically scan the document, send the data to the host in any of the ways described herein, and the input device software resident on the host will then cause a pop-up window to appear on the screen where the image of the scanned document appears." (col. 16, lines 57-63). Thus,

Art Unit: 2622

when the host computer stops its activity after receiving the interruption signal from the input device (the image transfer device is connected to the computer), it functions as a part of the transfer device since it uses the software programs of the input device to operate. When the input device does not detect any insertion of the document (the image transfer device is not connected to the computer), there is no communication between the input device and the host computer since there is no interruption needed, the host computer has menus generated by its own programs.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotte (US Patent No. 5,499,108).

Concerning claim 1, Cotte discloses an electronic assembly (Figs. 10, 12) comprising an image transfer device (214, 210, 250) for reading and transferring an image from a first medium (216), the image transfer device including a reader (CCD) for reading the image on the first medium 216, and a display (250) for displaying an image transfer menu for effecting transfer of the image; and a computer (210); wherein when the image transfer device is inactive or not in

Art Unit: 2622

used, a first type of menu is displayed on the display device, and when the image transfer device is active (the detection of the insertion of the document), a second type display menu is available for display on the display device.

Cotte does not specifically teach the case of the image transfer device 214 is connected or not connected to the computer 210. However, Cotte teaches the case when the transfer device 214 connected to the computer 210 upon detecting the insertion of paper or document to be scanned and transferred the scanned document to the computer while a display menu (Fig. 17) is display on the display screen; and the case when the transfer device 214 is inactive, the display 250 display a regular menu for the computer 210. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider Cotte teaches 2 different display menus in 2 different cases whether the transfer device is connected to the computer or not, since the displayed menu in Fig. 17 is different from the display menu of the computer since it contains the scanned document and other instructions for the user to select a menu option for the scanned document.

Cotte teaches that the display 250 is exclusively used by the transfer device. For instance, the insertion of the paper in the input device 214 causes a code to be sent over the RS232 cable to the input device software resident on the host 210. This code is an interrupt which vectors processing by the host to a service routine which then reads the incoming serial data from the input device and stores it in a file. "The interrupt causes the host 210 to stop whatever it is doing" (col. 15, lines 7-21) and "The software of the input device resident on the host also generates a drop down menu 250 representing options to the user regarding what should be done with the scanned image." (col. 10, lines 29-58). Thus, since the input device 214

Art Unit: 2622

can control the host computer and has the priority over the host computer, the display is exclusively used by the image transfer device for displaying an image transfer menu for effecting transfer of the image scanned by the input device 214 (Fig.17).

Concerning claims 2-3, Cotte further teaches that the image transfer device is at least one of a copier, a fax machine or a printer (Figs.10, 11A); and it includes a processor (352, Fig.11A), for controlling operation of the device, a memory (132), a user interface (134).

Concerning claims 4-13, Cotte further teaches that the second types of the image transfer menu is stored in the memory of the transfer device, the computer has software for enabling the display means to display the first or second type of menu wherein at least a portion of the second type of the image transfer menu is stored in the computer and the second type menu includes expanded features for operating the image transfer device; the first type of the menu includes a base set of different features which is commonly known for computer operations; the image transfer device is a fax machine and the extra feature is at least one of an extended phone log selection feature or adding a logo, a message or watermark; the image transfer device is adapted to transfer the image to a local/remote devices or printing device for printing the image; the computer is adapted for sending a polling signal (Figs. 10-18, 21-28; Abstract; col. 5, lines 45-58; col. 6, lines 19-29; col. 11, lines 24 - col. 12, line 66; col. 13, line 8 - col. 14, line 36; col. 15, lines 57-64; col. 16, lines 10-22; col. 16, line 52 - col. 17, line 10; col. 18, lines 35-57; col. 19, lines 14-35).

Concerning claims 14-18, Cotte discloses the subject matters as discussed in claims 1-13 above.

Art Unit: 2622

Claims 19-26 are method claims of apparatus claims 1-13. Claims 19-26 are rejected as claims 1-13.

Conclusion

7. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

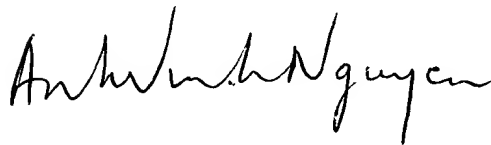
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the

Art Unit: 2622

organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

A handwritten signature in cursive script, appearing to read "Madeleine AV Nguyen".

Madeleine AV Nguyen
Primary Examiner
Art Unit 2622

AV
August 21, 2002